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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,685	02/04/2002	Jean Paul Laprade	81819A	6990

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KRIEGSMAN & KRIEGSMAN
665 Franklin Street
Framingham, MA 01702

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,685

Applicant(s)

LAPRADE, JEAN PAUL

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005 and 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-9,11-14,16-18,22-26,28-31 and 58 is/are pending in the application.
- 4a) Of the above claim(s) 16-18,22-26,28-31 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 9/15/2005 and 6/2/2005. Applicants' amendments to claims 1, 7, 16 and 24 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Election/Restrictions

4. Applicant's election with traverse of claims 1, 5-9 and 11-14 in the reply filed on 9/15/2005 is acknowledged. The traversal is on the ground(s) that "the Patent Office has failed to demonstrate that a serious burden would be imposed on the examiner if the examiner were to examine all of the species at the same time ... the Patent Office has failed to explain why, at this stage in the prosecution ... it would pose a serious burden for the examiner ..." (Remarks, page 8, second full paragraph). This is not found persuasive, because of the substantially unrelated amendments, which change the scope of each of the distinct inventions of independent claims 1, 16 and 58, require *separate* further search and reconsideration for each invention, a restriction requirement to elect species becomes necessary (see Office action dated 8/11/2005). In summary, claims 16-18, 22-26, 28-31 and 58 are now withdrawn as non-elected. Finally, in

response to Applicant's request for clarification regarding the statement on page 2 in Office action dated 8/11/2005 "the grounds of rejections ... are withdrawn for now ...", the Examiner notes that the statement merely indicates that the grounds of rejections are withdrawn from Office action dated 8/11/2005, and to be reconsidered upon the completion of species election.

The requirement is still deemed proper and is therefore made FINAL.

Rejections Based on Prior Art

5. Claims 1, 5-9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (Kingston (US 3616015), Parker et al. (US 4935300) and Laprade et al. (US 6099944)) in view of McCurry et al. (US 6391415) and Makar et al. (US 5891520), generally as set forth in section 4 of Office action dated 1/27/2005, together with the following additional reasoning and response to argument.

First, it is noted that independent claim 1 has been amended to recite, *inter alia*, "... (a) a carrier, said carrier consisting of a paper substrate overcoated with a layer of polyethylene; (b) a wax skim coat deposited onto said polyethylene layer of said carrier; and (c) ... said binder comprising a copolyester resin ...".

Second, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: In the Background of the Invention, Applicant has admitted that it is known art that heat-transfer labels are typically constructed as part of a heat-transfer label assembly, with one or more heat-transfer labels printed on a removable carrier web (page 1, third paragraph). Kingston teaches that a wax release layer can be

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affixed to the paper sheet, and an ink design layer is printed on the wax release layer (page 1, bottom paragraph). Parker teaches that the paper carrier web can be overcoated with a release layer of thermoplastic polyethylene to replace or obviate the need for a wax release layer (page 3, top paragraph). Laprade teaches an improvement over Parker by adding a skim coat of carnauba wax overcoated onto the polyethylene release layer to improve the release of the transfer label from the polyethylene-coated carrier web (page 4, top paragraph).

For claim 1, for the newly amended elements (a) and (b) of instant invention, the Examiner notes Parker and Laprade do teach amended elements (a) and (b), respectively, as set forth above. It should be noted that, in the absence of unexpected results, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. As to the newly amended element (c), the Examiner repeats that while Applicant's admitted prior art lacks express teachings regarding the amount of crosslinking resin and that the ink design layers are thermosetting within about 1-2 minutes at 250-325°F, it is noted that McCurry's invention is directed to a heat-transfer label, and McCurry expressly teaches that a heat-activated, cross-linking agent may be added in at least one of the color coat to improve water soak resistance. Preferably, the heat-activated, cross-linking agent is selected from the group consisting of urea and melamine formaldehyde, which has an activation temperature of greater than about 250°F, and preferably about 380°F (column 3, lines 8-18; column 8, lines 65-67). Additionally, the Examiner notes that the prior statement that "it is common knowledge that crosslinked melamine formaldehyde is

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inherently a thermoset polymer” is now taken as admitted prior art, because Applicant failed to specifically point out any supposed error in Examiner’s position in prior responses. Further, although McCurry is silent about the amount of melamine formaldehyde and time required for thermosetting, since McCurry’s heat-transfer process is essentially the same as the instantly claimed invention, it is the Examiner’s position that a suitable amount of melamine formaldehyde and time for thermosetting are either anticipated by McCurry, or obvious optimizations to one skilled in the art, motivated by the desire to thermoset ink design layer timely. In summary, it would have been obvious to one of ordinary skill in the art to modify Applicant’s admitted prior art to incorporate McCurry’s melamine formaldehyde into the ink design layers, motivated by the desire to improve the water soak resistance of the label. Finally regarding the newly added limitation that the binder comprises a copolyester, it is noted that Markar’s invention is also directed to a transfer label, and Markar expressly discloses in Example I a heat-set ink comprising Vitel® 2700 binder, which is a copolyester resin having a high tensile strength and a low elongation (column 5, lines 7-37), and the Examiner notes that, in the absence of unexpected results, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

With respect to Applicant’s argument “... the Patent Office has provided no explanation as to why one of ordinary skill in the art would have been motivated to combine the references ...” (Remarks, page 11, bottom paragraph), and arguments regarding Kingston, Laprade and McCurry references individually (Remarks, pages 13-

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20), the Examiner repeats that the recited limitations (a) and (b) are clearly well known prior art, and in the absence of unexpected results, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. In particular, other than pointing out structural differences between prior references and instant invention individually, the Examiner repeats that Applicant fails to provide any evidentiary support that the use of a wax skim would have necessarily required a protective layer to the transfer label to be functional, and it is well settled that Attorney arguments cannot take the place of evidence. It should be noted that the fact that, in the absence of a specific reasoning, merely pointing out that prior art discloses additional structure not claimed is insufficient as an evidence that the additional structure is integrally required for enablement. In particular, it is not seen how a functionally unrelated protective layer would have affected the releasing property of the releasing layer. Additionally, Applicant's argument "McCurry regards both protective clear coat layer ... and color coat layer ... as indispensable components" (Remarks, page 19, bottom paragraph) clearly fails to recognize that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. Finally, the Examiner notes that Applicant's argument also appears to be arguing against the instantly claimed invention as not enabling.

With respect to Applicant's argument "The Patent Office has failed to explain why ... one of ordinary skill in the art would have been motivated to replace Kingston ink design ... with McCurry color coat layer" (Remarks, page 20, middle paragraph), the Examiner respectfully reminds that nowhere the Examiner has suggested replacing

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Kingston ink design with McCurry color coat layer, and repeats that it would have been obvious to one of ordinary skill in the art to *modify* Applicant's admitted prior art to incorporate McCurry's melamine formaldehyde *into* the ink design layers, motivated by the desire to improve the water soak resistance of the label, as set forth above.

Applicants' argument is without merit to the present rejection.

Finally, with respect to Applicant's argument "McCurry explicitly teaches that it is **preferable** for cross-linking to be prevented during label transfer, one of ordinary skill in the art would not have been motivated ... to add a catalyst to the crosslinking agent to reduce the activation temperature at which cross-linking occurs since this would have the **exact opposite result**." (Remarks, page 22, top paragraph), the Examiner repeats that McCurry also teaches that "because of the mechanics of transferring a label, the heat-activated, crosslinking agent may have an activation temperature down to equal or about equal to the activation temperature of the adhesive and still perform satisfactory" (column 3, lines 22-26). As such, McCurry does teach lower activation temperatures for the ink design layer. In other words, McCurry's teaching does encompass the embodiment as claimed, the fact that McCurry also teaches preferable embodiment is irrelevant.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

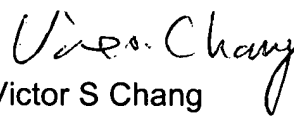
Geurtsen et al. (US 4555436) teaches that the barrier coating between wax release layer and ink layer (comprising Vitel®) is optional (column 11, lines 42-52).

Galante (US 4548857) teaches a transfer label composed of a carrier web, typically paper, overcoated with a release layer and ink design layer (column 5, lines 7-10).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
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10/20/2005